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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,768	09/12/2003	Howard Scott Forstrom	0918.0152C	5775

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EXAMINER	
VON BUHR, MARIA N	

ART UNIT	PAPER NUMBER
2125	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,768	FORSTROM ET AL.	
	Examiner	Art Unit	
	Maria N. Von Buhr	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2003 & 06 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 September 2003* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *01062004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 are pending in this application.

2. Examiner acknowledges receipt of Applicant's information disclosure statement, received 06 January 2004, with accompanying reference copies. This submission is in compliance with the provisions of 37 CFR §1.97. Accordingly, it has been taken into consideration for this Office action.

3. Examiner acknowledges receipt of Applicant's formal drawings. These drawings are acceptable.

4. The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.

5. Claims 1-8, 14 and 20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, there is no clear and proper antecedent basis for "the optimization experiment" (last line of the claim).

In claim 14, there is no clear and proper antecedent basis for "the power management profile" (line 1 of the claim).

In claim 20, there is no clear and proper antecedent basis for "the updated management profile" (last line of the claim).

The remainder of the claims are rejected as necessarily incorporating the above-noted ambiguities of their parent claims.

6. Claim 17 is objected to because -- to -- should be inserted before "perform" (line 3 of the claim) and "an" should be corrected to -- a -- (line 6 of the claim).

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR §1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR §1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR §3.73(b).

8. Claims 1-22 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-22 of co-pending Application Serial No. 10/660,764. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application, since the referenced co-pending application and the instant application are claiming common subject matter. The claims of co-pending Application Serial No. 10/660,764 contain every element of the claims of the instant application and as such anticipate the claims of the instant application.

Furthermore, there is no apparent reason why Applicant would be prevented from presenting claims corresponding to those of the instant application in the other co-pending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP §804.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by Applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 9 and 12-21 are rejected under 35 U.S.C. §102(a), as being clearly anticipated by Parent et al. (U.S. Patent Application Publication No. 2003/0097197; newly cited), which disclose a "method for enhancing process control including initiating a manufacturing process to create a product. The initiating includes setting a control on a machine in response to an initial system model. The manufacturing process is tuned in response to the initial system model. The tuning includes running the machine in response to

the initial system model, monitoring a primary output parameter of the product and performing an adaptation process while the manufacturing machine is running. The adaptation process includes adjusting the control on the machine, updating the initial system model to define an updated system model in response to adjusting the control and running said machine in response to said updated system model" (the abstract). See at least, Fig. 1, with associated text; and paragraphs 4, 5, 12, 13, 24 and 27.

11. Claims 1, 5-9 and 13-22 are rejected under 35 U.S.C. §102(b), as being clearly anticipated by Atkinson (U.S. Patent No. 5,991,883; newly cited), which discloses a "power conservation method for a portable computer with LCD display," including providing different modes of operation (analogous to the instantly claimed "generating" of a management profile), based upon stored correlations between operating parameters and desired performance, and monitored conditions and operating parameters of the computer system. See at least, the abstract; Fig. 1, with associated text; col. 2, line 55 - col. 4, line 17; col. 4, line 58 - col. 5, line 7; col. 7, lines 58-64; col. 8, lines 12-33.

12. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 10, 11 and 12 (alternatively) are rejected under 35 U.S.C. §103(a) as being unpatentable over Parent et al. (U.S. Patent Application Publication No. 2003/0097197), as applied above to claim 9, further in view of Applicant's admitted prior art, at pages 17-18 of the instant specification, wherein Applicant admits that Taguchi experiments, fractional factorial experiments, full factorial experiments, DOE experiments, Orthogonal Array experiments, and Latin Square Design experiments are well known types of optimization techniques in the art. It would have been obvious, to one having ordinary skill in the art, at the time the instant invention was made, to utilize such techniques in the system of Parent et al., since Parent et al. already disclose use of DOE experiments (paragraph 12), and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

14. Claims 2-4 and 10-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Atkinson (U.S. Patent No. 5,991,883), as applied above to claims 1 and 9, further in view of Applicant's admitted prior art, at pages 17-18 of the instant specification, wherein Applicant admits that Taguchi experiments, fractional factorial experiments, full factorial experiments, DOE experiments, Orthogonal Array

experiments, and Latin Square Design experiments are well known types of optimization techniques in the art. It would have been obvious, to one having ordinary skill in the art, at the time the instant invention was made, to utilize such techniques in the system of Atkinson, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for Examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

16. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Applicant is advised to carefully review the cited art, as evidence of the state of the art, in preparation for responding to this Office action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria N. Von Buhr whose telephone number is 571-272-3755. The examiner can normally be reached on M-F (9am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 571-272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maria N. Von Buhr
Primary Patent Examiner
Art Unit 2125

MNVB
6/10/05